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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,340	06/02/2006	David S. Garvey	0102258.00368US2	8446
24395	7590	12/23/2008		
WILMERHALE/DC 1875 PENNSYLVANIA AVE., NW WASHINGTON, DC 20004			EXAMINER NOLAN, JASON MICHAEL	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 12/23/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/581,340	<b>Applicant(s)</b> GARVEY ET AL.	
	<b>Examiner</b> JASON NOLAN	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/03/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is responsive to Applicant's Response to Election/Restriction, filed 10/21/2008. Claims 1-20 are pending in the instant application.

#### ***Information Disclosure Statement***

Applicants' information disclosure statement (IDS), filed on 08/02/2007 has been considered. Please refer to Applicants' copy of the 1449 submitted herein.

#### ***Response to Restriction***

Applicants' election without traverse of Group I: Claims 1-4, 11-15, 19, & 20 is acknowledged. The Examiner also acknowledges the election of species: Example 4, as a representative compound. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Group II: Claims 5-10 & 16-18 are withdrawn from further consideration as being drawn to a non-elected invention.

#### ***Election/Examination of Species***

Examination will begin with the elected species. As per MPEP 803.02, if the elected species is found to be unpatentable, the provisional election will be given effect and all other claims to species will be withdrawn from consideration. If the elected

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species is found to be allowable, the search will be expanded by the Examiner to consider additional species and subgenera within the generic formula until:

- I. An art rejection can be made, or
- II. The genus claim is found to lack unity of invention, or
- III. The claims have been searched in their entirety.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

Example 4 in the specification has been found to be allowable. As such, the search was expanded to consider additional species (a subgenus) within the general formula I until either an art rejection can be made or until the genus claim is found to lack unity of invention. In this case, the search was expanded to non-elected species within formula I until an art rejection was found. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. As per MPEP 803.02, when prior art is found that anticipates formula I with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration.

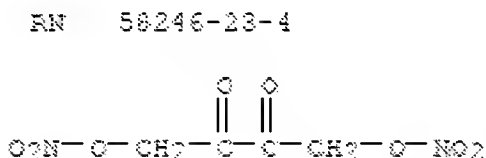
***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 & 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Nikolaeva et al. (Izvestiya Vysshikh Uchebnykh Zavedenii, Khimiya i Khimicheskaya Tekhnologiya 1975, 18(11), 1715-16). Attached in the previous Office Action was the CAS Abstract and structure RN 58246-23-4, shown below, wherein R<sup>1</sup> = K'; Z = O; T3 = bond; and R2 = K'; K' in both instances = ONO2.



Should Applicant's amend formula I to overcome this rejection, examination will continue until either an art rejection can be made or until the claims have been searched in their entirety.

***Claims Withdrawn***

Claims 2, 4, 11-15, 19, & 20 are withdrawn from further consideration for containing non-elected subject matter.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Nolan whose telephone number is (571) 272-4356 and e-mail is [Jason.Nolan@uspto.gov](mailto:Jason.Nolan@uspto.gov). The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on (571) 272-0699. The USPTO fax number for applications is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, (either Private PAIR or Public PAIR). Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For questions on Private PAIR system, contact the Electronic Business Center at (866) 217-9197.

/Jason M. Nolan/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626